

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/789,946	1/19/07	ADRIAN BUCKLEY, ET AL.	1578.122

Title: **APPARATUS, AND ASSOCIATED METHOD FOR  
FACILITATING NETWORK SELECTION BY A  
MOBILE NODE PURSUANT TO A PACKET DATA  
COMMUNICATION SERVICE**

--

Art Unit	Paper Number
----------	--------------

Correspondence Address:

ROBERT H. KELLY  
SCHEEF & STONE LLP  
5956 SHERRY LANE  
SUITE 1400  
DALLAS, TEXAS 75225

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 537,783  
Grant Date: 02-Mar-07

**This license is granted retroactively to  
the date(s) and the country(s) indicated  
on the attached decision.**

Approved:

  
for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license does not empower the filing of any applications, amendments, supplements or continuances originating in this country which disclose inventions, modifications, or variations not disclosed in the subject matter identified above.

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Office of Foreign Assets Control, Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

**LICENSE FOR FOREIGN FILING**

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Robert H. Kelly  
SCHEEF & STONE, L.L.P.  
5956 Sherry Lane, Suite 1400  
Dallas, Texas 75225

In re: Buckley et al . :DECISION ON REQUEST  
Serial No.: 10/789,946 :UNDER 37 CFR 5.25  
Filing date: February 27, 2004  
Docket No: 1578.122

Title: APPARATUS, AND ASSOCIATED METHOD, FOR FACILITATING NETWORK SELECTION  
BY A MOBILE NODE PURSUANT TO A PACKET DATA COMMUNICATION DEVICE

This is a decision on the petition filed on January 19, 2007 for retroactive foreign filing license.

It has been determined that a retroactive license for foreign filing under 35 U.S.C.184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under a secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R 5.11 through error and without deceptive intent.

**Country**

**Date**

EUROPEAN PATENT OFFICE

February 27, 2004

Ian J. Lobo  
Patent Examiner  
(571) 272-6974

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ADRIAN BUCKLEY, ET. AL.  
For : APPARATUS, AND ASSOCIATED METHOD FOR FACILITATING NETWORK  
SELECTION BY A MOBILE NODE PURSUANT TO A PACKET DATA  
COMMUNICATION SERVICE  
U.S. Serial No.: 10/789,946  
Filed: 27 FEBRUARY 2004  
Group Art Unit: 2151  
Examiner: UNKNOWN  
Docket No.: 1578.122

Mail Stop Petition  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED  
JAN 19 2007  
LICENSING &...

**PETITION PURSUANT TO 37 C.F.R. 5.25 FOR RETROACTIVE LICENSE**

Dear Sir:

Petition is hereby made for grant of a retroactive license under 35 U.S.C. 184 relating to the above-captioned patent application.

The patent application was filed with the USPTO on February 27, 2004. On the same date, an unlicensed patent application containing substantially identical material was filed with the European Patent Office.

A verified statement of the undersigned practitioner is enclosed under separate title.

The verified statement includes averments that the subject matter in question was not under a secrecy order at the time it was filed abroad and that it is not currently under a secrecy order.

The verified statement further includes averment that the proscribed foreign filing was discovered on 14 November 2006, and this petition is submitted as of the date noted below. Therefore, the requested retroactive license is believed to be diligently sought.

The verified statement still further avers that the material was filed abroad through error and without deceptive intent.

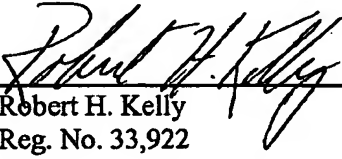
Application No. 10/789,946

The Commissioner is hereby authorized to debit the deposit account for all fees, including the petition fee required in 37 C.F.R. 1.17 (g), pursuant to this petition.

Consideration, and grant, of this petition is respectfully requested.

Respectfully submitted,

Dated: 19 Dec 06

  
Robert H. Kelly  
Reg. No. 33,922

SCHEEF & STONE, L.L.P.  
5956 Sherry Lane, Suite 1400  
Dallas, Texas 75225  
Telephone: (214) 706-4201  
Fax: (214) 706-4242  
[robert.kelly@scheefandstone.com](mailto:robert.kelly@scheefandstone.com)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: **ADRIAN BUCKLEY, ET. AL.**  
For : **APPARATUS, AND ASSOCIATED METHOD FOR FACILITATING NETWORK  
SELECTION BY A MOBILE NODE PURSUANT TO A PACKET DATA  
COMMUNICATION SERVICE**  
U.S. Serial No.: **10/789,946**  
Filed: **27 FEBRUARY 2004**  
Group Art Unit: **2151**  
Examiner: **UNKNOWN**  
Docket No.: **1578.122**

Mail Stop Petition  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**VERIFIED STATEMENT OF FACTS OF ROBERT H. KELLY**

Dear Sir:

I, Robert H. Kelly, affiant herein, state and declare as follows:

1. I am a patent attorney, registered to practice before the USPTO, registration number 33,922.
2. I have represented Research In Motion, Ltd., a Canadian company having a primary having a primary place of business of 295 Phillip Street, Waterloo, Canada NTL 3W8, before the USPTO in various matters, dating back to 2002.
3. I prepared the patent application of the above-captioned serial number on behalf of Research In Motion.

4. The inventors of the claimed invention of the patent application are Adrian Buckley, a British citizen, who resides at 413 Montclair, Tracy, California, 95276, U.S.A, Atul Asthana, a Canadian citizen, who resides at 4 Renate Place, Unionville, Ontario, L3R 2Y1, Canada, George Baldwin Bumiller, an American citizen, who resides at 39 Lakeview Terrace, Ramsey, New Jersey, 07446-2026, U.S.A., and Bokinakere Subbarao Sundresh, a British citizen, who resides at 18 Skylark Close, Basingstoke, Hampshire, RG22 5UR, United Kingdom.

5. I filed the patent application on 27 February 2004 with the USPTO.

6. Concurrent with the filing of the patent application, and prior to issuance of a foreign filing license, I instructed a European associate to file a European patent application with the European patent office on the same date, that is, 27 February 2004.

7. Responsive to my instructions, a European patent application, substantially identical to the corresponding patent application filed in the USPTO was filed on 27 February 2004 and constitutes the unlicensed patent application. An associated Canadian patent application, claiming priority of the European patent application, was filed just prior to the twelve month anniversary of 27 February 2004 filing date.

8. The subject matter of the patent application was not under a secrecy order at the time it was filed abroad and that it is not currently under a secrecy order.

9. In many other patent matters that I handled on behalf of Research In Motion, Ltd., the inventors resided in Canada, or elsewhere outside of the United States. With those other patent matters, I regularly caused patent applications to be filed both before the USPTO and the EPO on the concurrent dates pursuant to standard operating instructions of Research In Motion.

10. When I provided instructions to the European associate to file the subject patent application with the EPO on 27 February 2004, I did not consider the need to first obtain a foreign filing license. I believe that I caused the patent application to be filed abroad through

error and without deceptive intent without first obtaining the required license as I failed even to consider any issue regarding the foreign filing license.

11. Research In Motion, Ltd. Has standard operating instructions relating to foreign filing licenses, that states in pertinent part, "prior to filing or initiating the filing of a patent application in a non-US patent office, a non-US patent agency, or an international agency other than the U.S. Receiving Office, you must determine whether or not a foreign filing license will be required from the U.S. Patent and Trademark Office." This standard operating instruction was in place as of the date of filing of the European patent application.

12. I did not review the standard operating instructions at the time of filing of the European patent application. I believe that I caused the patent application to be filed abroad through error and without deceptive intent without first obtaining the required license further as I failed to review the standard operating instructions that would have refreshed my recollection and alerted me to the need first to obtain the foreign filing license.

13. A foreign filing license in the above-captioned patent application was granted by the USPTO on 24 May 2004 together with issuance of the filing receipt.

14. On 14 November 2006, I was alerted to the problem relating to the filing abroad of the patent application without first obtaining the foreign filing license.

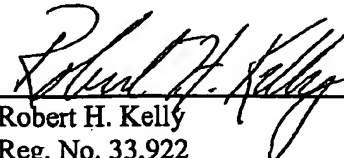
15. I am aware that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C.1001) and may jeopardize the validity of the application and

Application No. 10/789,946

any patent issuing thereon. I further declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true.

Respectfully submitted,

Dated: 19 Dec 06

  
Robert H. Kelly  
Reg. No. 33,922

SCHEEF & STONE, L.L.P.  
5956 Sherry Lane, Suite 1400  
Dallas, Texas 75225  
Telephone: (214) 706-4201  
Fax: (214) 706-4242  
[robert.kelly@scheefandstone.com](mailto:robert.kelly@scheefandstone.com)



United States Patent and Trademark Office  
- Sales Receipt -

01/22/2007 NNICHOLS 00000015 502032 10789946

01 FC:1463 200.00 DA